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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,177	01/21/2004	Loretta E. Allen	84196DF-P	4773

7590 12/29/2005  
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EXAMINER
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FUREMAN, JARED

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/762,177

Applicant(s)

ALLEN ET AL.

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt is acknowledged of the amendment, on 10/12/2005, which has been entered in the file. It is acknowledged that this application is a divisional of application serial number 10/310,519. The parent application has been reviewed, and it is noted that a restriction requirement was made in the parent application, thus precluding a double patenting rejection over related application serial numbers 10/761,671 and 10/762,169. Claims 1-3 are pending.

1. The indicated allowability of claims 1 and 2 is withdrawn in view of the newly discovered reference(s) to Yamauchi et al (US 5,575,507). Rejections based on the newly cited reference(s) follow.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al (US 5,575,507).

Yamauchi et al teaches a method, comprising the steps of:

a) forming a first indicia (information 3, see figure 1 and column 3, lines 38-39) in an image layer (layer 8, see figure 1 and column 3, lines 6-13) on a media (center core 7, see figure 1 and column 3, lines 6-13);

b) forming a second indicia in a protective overlayer (the selective application of protective layer 4 provides a second indicia in the protective overlayer, see figure 1 and column 3, lines 49-65) that is identical in content to, and in register with said first indicia (see figure 1), said protective overlayer being substantially transparent (the protective layer 4 is a transparent coating material, see column 3, lines 49-52) so as to allow said first indicia to be read through said protective overlayer; said second indicia having a physical topography which is identical in content to and in registration with a the first indicia (see figure 1) (also see figures 1, 10, column 1, lines 10-15, column 2, lines 3-20, column 3, lines 4-65, column 8, line 12 - column 9, line 15).

Yamauchi et al fails to specifically state that the first and second indicia (the information 3 and layer 4, respectively) are provided as machine readable indicia; c) reading the physical topography of said second indicia on said overlayer and said first indicia on said media by a machine so as to obtain information encoded therein; and d) interpreting said encoded information so as to obtain said encoded information.

However, Yamauchi et al does state that the card may be provided with a bar code (see column 3, lines 29-34). Providing a bar code also implies the steps of reading the bar code so as to obtain information encoded therein and interpreting said encoded information so as to obtain said encoded information, since the purpose of providing a bar code is to provide encoded information which can be read by a machine and decoded to obtain the encoded information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the teachings of Yamauchi et al, the first and second indicia are provided as machine readable indicia; c) reading the physical topography of said second indicia on said overlayer and said first indicia on said media by a machine so as to obtain information encoded therein; and d) interpreting said encoded information so as to obtain said encoded information; in order to allow machine reading of the indicia, which is more efficient and more accurate than manual reading/entry of information.

### ***Response to Arguments***

5. Applicant's arguments with respect to claim 3 have been considered but are moot in view of the new ground(s) of rejection. As discussed above, Yamauchi et al teaches/suggests the claimed invention.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jones et al (US 2005/0161512), Zeiter et al (US 6,494,491), Hill

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et al (US 6,267,052 B1) and Maurer et al (US 4,507,346) all teach methods for encoding indicia on a media.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (571) 272-2391. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Jared J. Fureman*  
Jared J. Fureman  
Primary Examiner  
Art Unit 2876

December 14, 2005